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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,959	01/02/2001	Uwe Hansmann	DE9-1999-0077	9951
47049	7590	07/20/2006	EXAMINER	
FERENCE & ASSOCIATES 409 BROAD STREET PITTSBURGH, PA 15143			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 07/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/752,959	HANSMANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Charles Kyle	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 May 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-8,10-14,16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-8,10-14,16 and 18-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-5, 8 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,029,150 *Kravitz* in view of US 6,023,689 *Herlin et al.*

**As to Claim 1,** *Kravitz* discloses the invention substantially as claimed, including in a method of payment in a purchasing action (Col. 12, lines 49-51) performed by means of an electronic communication device (Col. 11, lines 57-60) between a customer using said electronic communication device (Col. 12, lines 45-49) and a provider offering goods or services (Col. 12, lines 51-54), steps of:

building up a connection between said customer and said provider via a communication channel of said communication device (Col. 12, lines 45-51) and authorization of a customer to give a money transfer order (Col. 7, lines 19-45. See also Col. 29, line 19 to Col. 32, line 54 for details of authorization);

upon receipt of a purchase order from said customer (Col. 12, lines 49-51), issuance of an electronic bill by said provider and transmission of said electronic bill to said customer (Col. 12, lines 51-54);

upon acknowledgement of said electronic bill by said customer transmission of a money transfer order from said customer to a payment provider (Col. 12, lines 56-59; Col. 12, lines 15-22);

execution of said money transfer order by said payment provider by debiting an account of said customer (Col. 12, line 60 to Col. 13, line 12);

sending a receipt of payment to said customer and forwarding said receipt of payment to said provider offering goods or services (Col. 13, lines 13-26).

*Kravitz* does not specifically disclose the newly recited limitation of identity authorization of a customer by using a SIM. *Herlin* discloses the use a SIM for authentication at Col. 2, lines 10-40. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to perform authentication using the SIM of *Herlin* because this would facilitate secure payment, as set forth by *Herlin* at Col. 10, line 40 to Col. 12, line 30.

**With respect to Claim 3,** *Kravitz* discloses authentication by a communication provider via a service channel at Col. 12, line 55 to Col. 13 line 11 and Col. 29, lines 10-17.

**With respect to Claim 4,** *Kravitz* discloses authentication before transmission of a money transfer order at Col. 25, line 30 to Col. 27, line 23.

**With respect to Claim 5,** *Kravitz* discloses authentication after transmission of a money transfer order at Col. 29, line 18 to Col. 32, line 53.

**With respect to Claim 8,** *Kravitz* discloses the use of an Internet connection at Col. 11, lines 50-60.

**Concerning Claims 18-19,** *Kravitz* further discloses use of a digital signature at Col. 8, lines 41-56 and confirmation of the digital signature at Col. 8, lines 35-40.

**Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,029,150 *Kravitz* in view of US 6,023,689 *Herlin et al* and further in view of US 2002/0111164 *Ritter*.**

**As to Claim 16,** see the discussion of Claim 1. *Kravitz* further discloses that a payment provider maintains accounts for customers at Abstract, at least. *Kravitz* does not specifically disclose that the payment provider is a telecommunications company. *Ritter* discloses this limitation at 46. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to use the capabilities of a telecommunications company to maintain accounts disclosed by *Ritter* because such companies transfer account data and were technologically “savvy” enough to establish account maintenance systems and procedures.

**Claims 6-7, 10-13 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,029,150 *Kravitz* in view of US 6,023,689 *Herlin et al* and further in view of US 6,574,314 *Martino*.**

**With respect to Claim 6,** see the discussion of Claim 1. *Martino* discloses use of a service (data) channel for transmission of transaction data from a data transaction server at Col. 23, lines 35-59. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the service channel of *Martino* to transmit the transaction data of *Kravitz* because this would transmit transactions data without using valuable voice channel bandwidth.

**With respect to Claim 7,** see the discussion of Claim 1. *Martino* discloses use of a voice channel at Col. 7, lines 30-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to use a voice channel so as to perform simple verbal placement of payment instructions and follow on information.

**With respect to Claim 10,** *Kravitz* discloses the invention substantially as claimed. See the discussion of Claim 1. *Kravitz* does not disclose limitations relating to use of voice and service channels for transmission of the payment related documents. *Martino* discloses the use of two channels (Col. 7, lines 19-43) in a cellular system (Col. 3, lines 52-59) for transmission of payment related documents (Col. 23, lines 35-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to use the two channel cellular implementation of *Martino* because this would provide a familiar payment device having the capability of simultaneously presenting data (on screen 20, Fig. 5A) and allowing voice communication (via handset 54, Fig. 5A), thus relieving a user from having to switch between channels for different types of information. See *Martino* at Col. 7, lines 30-43.

**With respect to Claim 11,** *Kravitz* does not specifically disclose authentication via a service channel. *Martino* discloses this limitation at Col. 20, line 56 to Col. 21, line 4 and Col. 7, lines 27-34. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to include the data channel authentication of *Martino* because this would provide transactions security without using valuable voice channel bandwidth

**With respect to Claim 12,** see the discussion of Claim 10 and *Kravitz* further discloses computer program product at Col. 13, line 65 to Col. 17, line 67.

**With respect to Claim 13,** *Kravitz* discloses computer program product databases at Col. 13, line 65 to col. 17, line 67. Official Notice is taken that computer readable media are stored on computer readable media. Examples include cache, memory, fixed disks, and removable media. It would have been obvious to one of ordinary skill in the art at the time of the invention to use such media to store the computer program product databases to store important data.

**As to Claims 21-22,** see the discussion of Claims 12 and 18-19.

**Claim 14, 20 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,029,150 *Kravitz* in view of US 6,023,689 *Herlin et al* and US 6,574,314 *Martino* and further in view of US 2002/0100798 *Farrugia et al.*

**Concerning Claims 14, 20 and 23,** *Kravitz* discloses the invention substantially as claimed. See the discussion of Claims 13, 1 and 12. *Kravitz* does not specifically disclose that the communication device is a personal computer using a SIM. *Farrugia* discloses this limitation at Abstract, Summary of the Invention and paras. 15-30.. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Kravitz* to use such a personal computer because this would provide the security of SIM authorization to a broader array of devices for payment processing.

#### ***Response to Arguments***

Applicant begins substantive argument at mid-page 8, stating that there is no teaching in *Kravitz* that it can be modified to use cellular technology. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness

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can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or *in the knowledge generally available to one of ordinary skill in the art*. Emphasis added. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to modify *Kravitz* to facilitate secure payment, as set forth by *Herlin* at Col. 10, line 40 to Col. 12, line 30. This motivation is given above, and was given in the prior office action. Applicant makes no substantive comment on this motivation, merely asserting incorrectly that the motivation must be found in the references themselves. Applicant fails to note that artisans working in the financial payment art continually seek new mechanisms for such payment; use of cellular technology is an obvious and effective way to facilitate payment and draw customers. See the *Gallagher* reference fro support of these comments.

Applicant's inability to conceive of a way to modify *Kravitz* to use cellular technology hardly makes the modification impossible or even particularly difficult. Applicant appears to quote his/her Specification, attempting to show that Applicant's *specification* teaches away from the combination of references. This is hardly a showing that the references teach away from each other; Applicant does not even suggest that the references are incompatible.

Applicant finds much to dislike in the combination, but provides no convincing argument as to why it would be unobvious to use cell phones to make payments. The Examiner notes that *Kravitz* discloses several electronic technologies for payment at Background and Summary of the Invention. The use of cellular technology disclosed by *Herlin* is just another effective and obvious route to make such payments.

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The rejections are maintained.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7,031,939, *Gallagher et al* for its teaching of the use of cellular technologies to make payments at Col. 5, lines 34-58.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk  
July 17, 2006

**Primary Examiner**  
**Charles Kyle**  
**Art Unit 3624**

